



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,072	08/15/2001	Robert G. Burke	T8466357US	8932

26912 7590 11/15/2005

GOWLING LAFLEUR HENDERSON LLP  
SUITE 1600, 1 FIRST CANADIAN PLACE  
100 KING STREET WEST  
TORONTO, ON M5X 1G5  
CANADA

EXAMINER

KAVANAUGH, JOHN T

ART UNIT PAPER NUMBER

3728

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/929,072

Applicant(s)

BURKE ET AL

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4-7 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 16-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5,7 and 11-13 is/are allowed.
- 6) ☒ Claim(s) 2,10,14,15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Nov. 2, 2005 has been entered.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

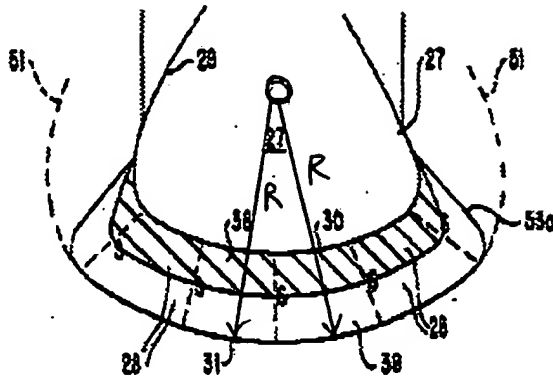
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

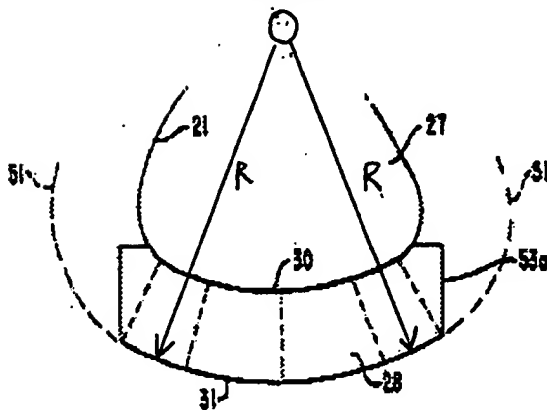
2. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by US 5317819 (Ellis).

Ellis teaches an article of footwear comprising an upper, a midsole/outsole having a heel region with the outer face having a convex curvature, said convex curvature has a radius with the curvature approximately coincident with the sagittal plane centre of mass of the calcaneus of the wearer's foot (**see the marked-up figure 15 and 22B below**). All of the curves appear to pivot around the sagittal plane centre of mass of the calcaneus of the wearer's foot in the lengthwise direction (see the heel region in figure 20E) and widthwise direction (see the figures below) and therefore have a generally spherical configuration over its total surface.

**FIG. 15**



**FIG. 22B**



***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3728

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10/2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference(s) as applied to claim 2 above, and further in view of US 5404659 (Burke et al).

Burke teaches the midsole/outsole with a dome shaped catalyst having an apex with a maximum height from 5.28% to 7.6% of the length of the sole, see col. 4, lines 5-7. It would have been obvious to provide the sole unit as taught above with a dome shaped catalyst, as taught by Burke, to provide a more energy efficient footwear.

Regarding the range of 1 to 5%, it would appear to be obvious to adjust the height of the apex of Burke, especially within 0.28%, to suit a particular foot or bone structure.

5. Claims 10/2, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference(s) as applied to claim 2 above, and further in view of US 6301807 (Gardner).

Gardner teaches the midsole/outsole with a dome shaped catalyst having an apex with a maximum height from 1 to 5% of the length of the sole, see col. 4, lines 29-32. Burke also teaches the catalyst with receptacles having vertical sidewalls for accommodating a resilient member; see figures 9-14. It would have been obvious to provide the sole unit as taught above with a dome shaped catalyst and receptacle with vertical sidewalls, as taught by Gardner, to provide a more energy efficient footwear.

Art Unit: 3728

***Response to Arguments***

6. Applicant's arguments filed Nov. 2, 2005 have been fully considered but they are not persuasive.

See the rejection above wherein the examiner addresses the new limitations added to the claim.

***Allowable Subject Matter***

7. Claims 4,5,7 and 11-13,17 are allowed.

***Conclusion***

8. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

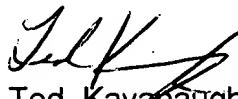
--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
November 11, 2005